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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO. KM
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EXAMINER

ART UNIT	PAPER NUMBER
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8

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/529,205

Applicant(s)

KATO ET AL.

Examiner

Bridget E. Bunner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133)
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-6 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

1. ☐ Notice of References Cited (PTO-94)

16. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)

17. ☐ Information Disclosure Statement(s) (PTO-1449; Paper No(s): _____)

18. ☐ Interview Summary (PTO-413; Paper No(s): _____)

19. ☐ Notice of Informal Patent Application (PTO-152)

20. ☐ Other

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Groups 1-10, claim(s) 1-6, in part, drawn to one of 10 proteins comprising an amino acid sequence (SEQ ID NOs: 1-10). For example, if Group 2 is elected, the claims will be searched to the extent that they read on SEQ ID NO: 2.

Groups 11-30, claim(s) 1-6, in part, drawn to one of 20 cDNA molecules (SEQ ID NOs: 11-20, 21, 23, 25, 27, 29, 31, 33, 35, 36, 39) coding for a protein, a vector, and a eukaryotic cell transformed with the cDNA. For example, if Group 22 is elected, the claims will be searched to the extent that they read on SEQ ID NO: 23.

2. The inventions listed as Groups 1-10 and 11-30 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Claims 1-6 broadly encompasses the amino acid sequences of 10 different polypeptides. The amino acid sequences of Groups 1-10 are different lengths, composed of different amino acids, and are structurally and functionally unrelated, each to each other. Accordingly, each of the 10 different protein sequences recited in claims 1-6 are not so linked under PCT Rule 13.1 and are thus placed in 10 different inventive Groups numbered 1-10, respectively.

Claims 1-6 broadly encompass the nucleic acid sequences of 20 different genes or fragments. The nucleic acid sequences of Groups 11-30 are different lengths, composed of different nucleic acids, and are structurally and functionally unrelated, each to each other. The nucleic acid sequence imparts structural and functional differences in each gene which affect properties such as expression levels, tissue specific expression patterns, mRNA half lives, cellular localization of the gene product, etc. Furthermore, each gene encodes a different protein product which is not sufficiently linked by structural or functional features. Accordingly, each of the 20 different

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3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

In order to be fully responsive, Applicant must select one from Groups 1-10, and one from Groups 11-30. Applicant is advised that neither 1-10 nor 11-30 are species election requirements; rather, each of 1-10 and 11-30 is a restriction requirement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bridget E. Bunner whose telephone number is (703) 305-7148. The examiner can normally be reached on 7:30-4:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (703) 308-4623. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Bridget E. Bunner

Bridget E. Bunner
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April 18, 2001